

REMARKS

Entry of this Amendment is proper under 37 CFR § 1.116, since no new claims or issues are raised and because issues for appeal are reduced, since the amendment to claim 1 eliminates non-statutory subject matter as an issue for appeal. Moreover, the Examiner will likely want to respond on the record to clarify and better articulate her position prior to proceeding to appeal, since the rejection currently of record clearly fails to heed the plain meaning of the claim language, as such language would be understood by one of ordinary skill in the art.

Applicants submit that, until the plain meaning has been properly recognized and addressed in the prior art rejection, the Examiner has failed to meet the initial burden of a *prima facie* rejection. It is pointed out that such clarification would require a rejection that is non-final, in order to permit Applicants to make a fair evaluation and adjustments in claim language, if required.

It is further requested that the Examiner place on record a more coherent response of her position. That is, in the "Response to Arguments" section on page 9 of the Office Action, it is difficult to understand what exactly the Examiner is attempting to point out.

Claims 1-16 and 21-38 are all the claims presently pending in the application.

It is noted that the claims have been amended solely to more particularly point out Applicant's invention for the Examiner, and not for distinguishing over the prior art, narrowing the claim in view of the prior art, or for statutory requirements directed to patentability.

It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 36-38 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to be enabled.

Claims 1-7 and 25-38 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1-16 and 21-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "LPEX User's Guide and Reference", 03/1996, IBM, 2nd Ed., pp. 1-37, in view of "Incrementally Imbedded Messages in an Edit View", 11/1995, IBM Technical Disclosure Bulletin, Vol. 38, Issue 11, pp. 1-5.

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These rejections are respectfully traversed in the discussion below.

I. THE CLAIMED INVENTION

Applicant's invention, as defined, for example, in the non-limiting embodiment of independent claim 1 (and substantially similarly in independent claims 8 and 13) is directed to a processing system for processing a document, comprising a plurality of modules on a signal-bearing medium that tangibly embodies a program of machine-readable instructions executable by a digital processing apparatus. The plurality of modules includes a programmable text processing module having means for loading the document and a parsing editor for initially parsing the document and thereafter incrementally parsing changes committed in the document.

A mark control module provides a means for setting a plurality of marks in the document, means for modifying the marks, and means for clearing the marks, and each of the marks comprising selected information in the document and means for linking the selected information with a command. The linking means and the means for setting are responsive to the operation of the parsing editor without user intervention. A graphical user interface module provides a means for displaying the document and means for controlling the display of the document. An edit control module provides means for controlling the text processing module, means for controlling the mark control module, and means for controlling the graphical user interface module.

The conventional systems, such as those discussed below and in the Related Art section of the present application, do not have such a structure, and fail to provide for such an operation.

Indeed, such features are clearly not taught or suggested by the cited reference.

II. THE REJECTION UNDER 35 USC §112, FIRST PARAGRAPH

The Examiner alleges that recently-added claims 36-38 contain subject matter which was not enabled in the specification.

Applicants respectfully disagree.

The data structure aspect of the present invention is clearly described in Figure 1. The data structure characteristic of the present invention, including its characteristic of being outside the document being parsed is clearly described throughout the specification, and particularly at lines 8-12 of page 5, lines 11-24 of page 7, with emphasis on line 15, and lines 3-4 and 7-24 of

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page 12. It is noted that page 12 even includes an exemplary listing of the components of one such data structure for an activemark of the present invention

Applicants, therefore, respectfully submit that one of ordinary skill in the art could not in any way agree with the Examiner that the data structure language of claims 36-38 was not described in the original specification in a manner that is enabling to one of ordinary skill in the art.

Thus, Applicants submit that the specification does indeed clearly describe, to one of ordinary skill in the art, that data structures are used in the present invention, that these data structures permit marks to be retained even though the document has been closed (e.g., because they are external to the document being parsed).

III. THE REJECTION UNDER 35 USC §101

The Examiner continues to allege that the "system" terminology of claim 1 can be construed as addressing a computer program *per se*, even though Applicants have stated on the record that one of ordinary skill in the art would consider a "system" as directed to hardware. Applicants continue to maintain their position, but choose to amend claim 1 simply to expedite prosecution. It is noted that claim 34 is also changed to better articulate the various possibilities for the "system" recited in claim 1 that the Examiner insists to be describing software.

IV. THE PRIOR ART REJECTION

The Examiner continues to allege that the primary reference "LPEX User's Guide and Reference" (hereinafter, "LPEX") teaches the present invention defined by independent claims 1, 8, and 13, except the Examiner concedes that LPEX fails to teach or suggest "... linking said selected information with a command." To overcome this deficiency, the Examiner relies upon "Incrementally Imbedded Messages in an Edit View" (hereinafter, "IBM").

Applicants respectfully disagree.

The Examiner states on page 5 of the Office Action:

"However, LPEX does not explicitly disclose "incrementally parsing changes committed in said document" and "linking said selected information with a command".

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IBM "Incrementally Imbedded Messages in a[n] Edit View" on pages 1 and 4 teaches an incremental parser and pages 1 and 2 teaches a message is inserted into the edit view which refers to the text immediately above; the parser highlights the text in error and provides a message that describes the error; once the error is corrected, the parser re-parses and removes all messages, in other words, the messages can be commands or suggestions for correcting an error from the edit window.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified (sic) IBM into LPEX to provide a way to incrementally parse a document and provide a message with each highlighted block of text, as taught by IBM, incorporated into the system of LPEX, in order to help users write programs in a Live Parsing Editing environment."

In response, Applicants respectfully submit that, to one of ordinary skill in the art, this evaluation recited above would not make much sense.

First, as best understood, the Examiner considers that ("*... in other words, the messages can be commands or suggestions for correcting an error from the edit window.*") one of ordinary skill in the art considers "error messages" as equivalent to "commands".

Applicants respectfully disagree and request that the Examiner, prior to proceeding to appeal, provide a properly combinable reference to support her position, should this rejection based on LPEX be maintained.

Second, LPEX already describes its repertoire of "commands" (see item 7 "Command Menu" on page 3, item 11 "Creating External Commands" on page 4, item 13 "LPEX Commands" on pages 5-8, item 15 "Default Synonyms for LPEX Commands" on page 8, and item 17 "Return Codes for LPEX Commands" on page 8.

The Examiner makes no attempt in the rejection of record to demonstrate that the discussion on page 15 (e.g., "Setting a Mark"), which the Examiner seems to consider as being related to the independent claim limitation describing the mark control module, involves a linking to any of these commands, let alone a "means for linking said selected information with a command."

Applicants further submit that, until such linking capability between the discussion on page 15 to one or more of the various commands listed in LPEX is made, the Examiner has failed to meet the initial burden of a *prima facie* rejection.

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It is further submitted that the Examiner's reliance on "IBM" is misplaced, since LPEX already has error messages, and since there is no suggestion in either LPEX or "IBM" that one of ordinary skill in the art considers an error message to be a "command", as the Examiner seems to have done.

Third, error messages are not "selected information in the document", as clearly required in the claim language. Therefore, even if LPEX were to be modified by "IBM", as urged by the Examiner, the plain meaning of the independent claims would not be satisfied.

Hence, turning to the clear language of the claims, in LPEX there is no teaching or suggestion of: "... a mark control module ... and each of said marks comprising selected information in the document and means for linking said selected information with a command", as required by claim 1. The remaining independent claims contain similar language.

Applicants further submit that the rejection currently of record also contains the following deficiencies in the prior art evaluation, which the Examiner is requested to clarify or address on the record prior to proceeding to appeal.

Relative to the rejection for claims 2, 14, 15, Applicants submit that one of ordinary skill in the art would not consider the highlighted error messages of "IBM" as being "selected marks".

Relative to the rejection for claims 3 and 6, Applicants submit that one of ordinary skill in the art would not consider the user's ability to "... navigate and manipulate messages within an edit window" as equivalent to "activating a command linked with said selected information."

Relative to the rejection for claims 4, 9, and 16, Applicants submit that one of ordinary skill in the art would not consider error messages as equivalent to the "marks" discussed on page 15 of LPEX, which the Examiner seems to consider to be "selected information".

Relative to the rejection for claim 7, Applicants submit that the evaluation fails to properly address that the mark described on page 15 of LPEX is linked to any commands described in LPEX, let alone "selectively linked to any of the commands." The command described on page 17 relates to starting the parsers. Applicants see no discussion on page 20 related to a command and request that the Examiner clarify what exactly is being pointed to on this page. Therefore, it appears that there is no discussion on either page 17 or page 20 that describes that a command can be linked to the mark described on page 15, let alone that any command can be linked to these marks.

Relative to the rejection for claims 10 and 11, Applicants submit that one of ordinary skill

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in the art would not consider error messages as equivalent to marks discussed on page 15 of LPEX or that highlight error messages is in any way satisfying the description of "... exclusively displayed ... according to conceptual relatedness is by type of activemark." Neither LPEX nor "IBM" teach or suggest different types of "marks" or "error messages".

There are no rejections addressing claims 21-28.

Relative to the rejection for claims 29 and 30, neither of these two claims are evaluated in accordance with the plain meaning of the claim language.

Relative to the rejection for claim 33, the rejection fails to heed the plain meaning of the claim language by evaluating the opposite of the claimed invention.

There is no rejection addressing claim 34.

Relative to the rejection for claims 36-38, Applicants submit that one of ordinary skill in the art would not agree with the Examiner that a macro "... invoked to facilitate the parser for color and emphasize of the data being displayed" is equivalent to a "data structure", as that term is understood in the art. Furthermore, the description in the final line on page 15, clearly teaches against using data structures external to the document being parsed, as follows: "Marks in the document are lost when you close the document."

That is, Applicants submit that, if "marks in the documents" were stored in data structures external to the document, then one of ordinary skill in the art would not have made this statement on page 15 of the primary reference that describes that closing the document causes the marks to be lost.

V. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-16 and 21-38, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

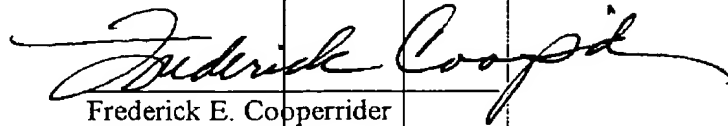
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

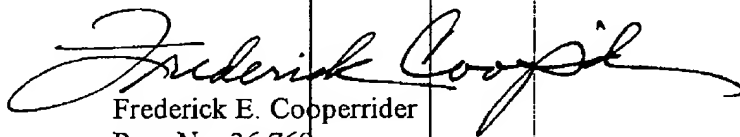
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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 this Amendment under 37 CFR §1.116 to Examiner A. Yuan on April 4, 2005.



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